



\$ 1624

Patent Application  
Attorney Docket No. PC11032A

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By

Mary C. Bickel

(Signature of person mailing)

Mary C. Bickel

(Typed or printed name of person)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Matthew Merrill Hayward, :

et al.

APPLICATION NO.: 09/872,731

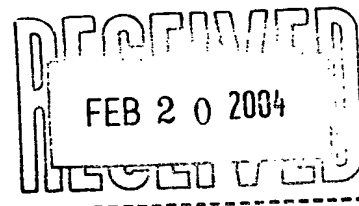
: Examiner: Liu, Hong

FILING DATE: June 1, 2001

: Group Art Unit: 1624

TITLE: HYGROMYCIN A DERIVATIVES :

Hon. Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450



RESPONSE TO THE AUGUST 13, 2003 OFFICE ACTION

Sir:

This is in full response to the Office Action mailed August 13, 2003.

Applicants have concurrently filed a Petition for a three-month Extension of Time, i.e., from November 13, 2003 up to and including February 13, 2004 (Two copies of the Petition are enclosed). Therefore, the present Response is being timely submitted.

REMARKS

Applicants note that the claim of priority was acknowledged in the Office Action.

Claims 1-8 were pending in the present application. Claims 1-8 will be under examination as Applicants made no amendment to the claims.

CLAIM REJECTION UNDER 35 U.S.C. §103

Claims 1-8 stand rejected under 35 U.S.C. §103 for allegedly being obvious over Hayward et al., WO 00/32616 (hereinafter "WO 00/32616").

Applicants respectfully disagree with this ground of rejection. Applicants have unexpectedly discovered that compounds of formula 1 possess superior antibacterial activities in the presence of 50% human serum when "each R<sup>3</sup> is independently selected from C<sub>6</sub>-C<sub>10</sub> aryl or 5-10 membered heteroaromatic, and the heteroaromatic and aryl moieties of the foregoing R<sup>3</sup> groups are substituted by a -CHR<sup>9</sup>NR<sup>11</sup>R<sup>12</sup> group and optionally substituted by 1 to 4 R<sup>4</sup> groups."

In support of the above argument, Applicants enclose herewith testing data comparing

compounds of the present invention and those of WO 00/32616. The comparative data shows, for example, that the inhibitory activity to Stau1095 (S. aureus 1095) by compound CP-733798, which claimed in the present application, is eight times more resistant to the presence of 50% human serum than compound CP-628295, a compound disclosed in WO 00/32616. Other examples also show similar superior properties of the compounds claimed in the present application.

Therefore, the claims 1-8 are nonobvious over the disclosure of WO 00/32616 as "superiority of a property shared with the prior art is evidence of nonobviousness," M.P.E.P. § 716.02 (a). Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

#### DOUBLE PATENTING REJECTION

Claims 1-8 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 13-16 of U.S. Patent No. 6,245,745 ("the '745 patent").

As stated in Applicants' response to the obviousness rejection and in the enclosed comparative testing data, Applicants have shown that the claimed compounds possess unexpectedly superior properties over those in claims 1-8 and 13-16 of the '745 patent. Therefore, claims 1-8 are nonobvious over claims 1-8 and 13-16 of the '745 patent because "superiority of a property shared with the prior art is evidence of nonobviousness," M.P.E.P. § 716.02 (a). Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.


#### CONCLUSION

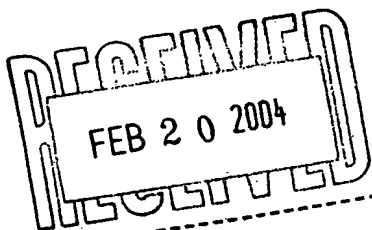
In view of the foregoings, further and favorable consideration of the present application and the issuance of a Notice of Allowance are respectfully requested.

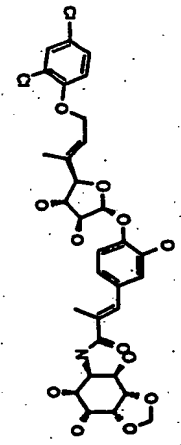
It is believed that no fee, other than the three-month extension of time fee, is required for the consideration of this Response. However, if any other fees are required, the examiner is authorized to charge such fees to our Deposit Account No. 16-1445.

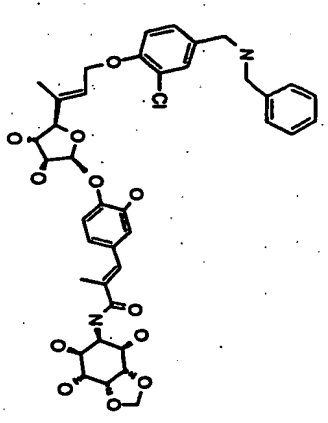
DATE: Feb 9, 2004

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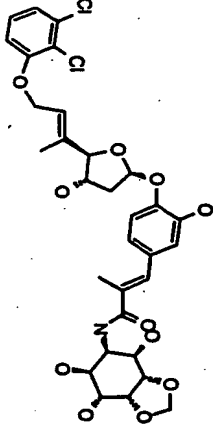


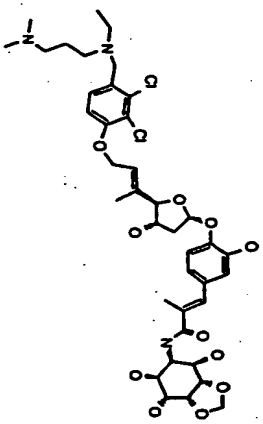
Compound	CP-628295
	
Chemist	G2897A
Compound Tested (3)	CTRL
STau1095	1.563
STau1095 +SER	50.000

Compound	CP-733798
	
Chemist	G2897A
Compound Tested (4)	CTRL
STau1095	25.000
STau1095 +SER	100.000

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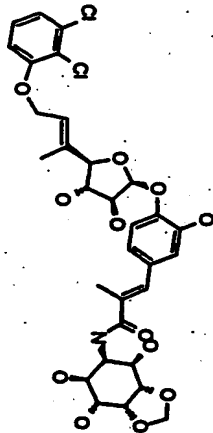
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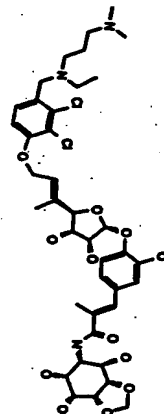
Compound	CP-657447
	
Chemist	G2897A
Compound Tested (1)	CTRL
STau1095	1.560
STau1095 +SER	50.000

Compound	CP-774911
	
Chemist	G2897A
Compound Tested (3)	CTRL
STau1095	6.250
STau1095 +SER	3.125

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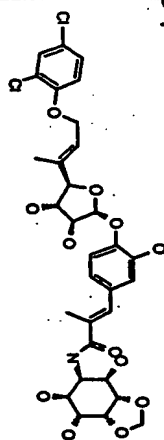
Compound	CP-629677
	
Chemist	
G2897A	CTRL
Compound Tested (1)	
STau1095	3.120
STau1095 +SER	100.000

Compound	CP-761667
	
Chemist	
G2897A	CTRL
Compound Tested (5)	
STau1095	25.000
STau1095 +SER	6.250

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Compound

CP-628295



Chemist

G2897A

CTRL

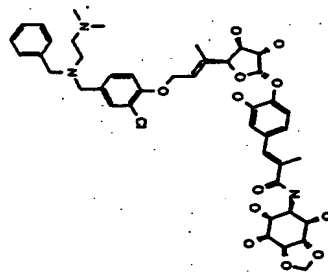
Compound Tested (3)

STau1095  
STau1095 +SER

1.563  
50.000

Compound

CP-745917



Chemist

G2897A

CTRL

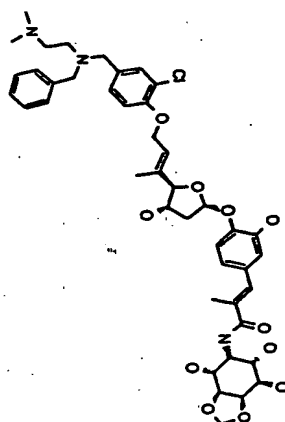
Compound Tested (2)

STau1095  
STau1095 +SER

6.250  
10.000

Compound

CP-774950



Chemist

G2897A

CTRL

Compound Tested (3)

STau1095  
STau1095 +SER

3.125  
1.250

